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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/553,524	04/20/2000	Charles Eric Hunter	**OO-0138	5419

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EXAMINER

KOENIG, ANDREW Y

ART UNIT	PAPER NUMBER
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2623

MAIL DATE	DELIVERY MODE
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12/26/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/553,524	Applicant(s) HUNTER ET AL.	
	Examiner Andrew Y. Koenig	Art Unit 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-33, 36-39, 41-45, 47-50, 57, 60-64, 114-118 and 121-157 is/are pending in the application.
- 4a) Of the above claim(s) 30-33, 36-39, 41-45, 47-50, 114-118 and 121-145 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 57, 60-64 and 146-157 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/1/07</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 2007 03 October have been fully considered but they are not persuasive.

The applicant disagrees with the examiner's characterization of Salganicoff as an agreement matrix (in one embodiment) is "for scheduling the *broadcast* of movies and other shows over a video distribution network which allows the simultaneous distribution of many channels from a head end to the set top multimedia terminals associated with many customer's television sets." (Emphasis added). Further, the applicant argues that the created virtual channels are received as additional offerings to regular broadcast transmissions. As such, the applicant concludes that the claimed selecting for storage is patentably distinct from selecting content for broadcast. The examiner disagrees based upon the teachings of Russo and Salganicoff taken as a whole. Russo teaches receiving content and selecting content for storage using a profile, but is silent on the profile based upon popularity, which is taught by Salganicoff. Moreover, one of ordinary skill in the art would recognize that the popularity portion of the Salganicoff's profile would be used within the system of Russo in that Russo recognizes that various criteria may be used in order for a movie to be stored, and recognizes that initial availability of a first-run movie are typically in great demand (col. 9-10, ll. 59-9) and Salganicoff is directed to providing the content to the users (which would clearly be performed within the environment of Russo).

In other words, the mere fact that there exists an embodiment of Salganicoff would scheduling movies for broadcast is independent does not preclude the use of the profile within the system of Russo. The examiner notes that the claimed blanket transmitting does not preclude existence of a virtual channel with broadcast programming.

2. Applicant's election without traverse of claims 30-33, 36-39, 41-45, 47-50, 114-118, and 121-157 in the reply filed on 03 October 2007 is acknowledged.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 146-151 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.
5. Independent claim 146 recites a "computer readable medium" is not supported in the disclosure as originally filed.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 146-151 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Since the disclosure provides no guidance as to the scope of a computer readable medium, there exist non-statutory embodiments such as a signals or carrier waves.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 57, 60, 146-147, and 152-153 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,619,247 to Russo in view of U.S. Patent 5,734,720 to Salganicoff.

Regarding claims 57, 146, and 152, Russo teaches blanket transmitting movies and music selections to customers via a cable television input or a satellite (col. 6, ll. 9-12, col. 7, ll. 29-34), and automatically recording a movie at a first user station of a first viewer, (Abstract, col. 9-10, ll. 38-10), which reads on at a first user station of a first viewer, automatically selecting desired digital data content from the blanket transmitted digital data content according to predetermined criteria.

Russo teaches playing back the selected movie, (figure 1; col. 3-4, ll. 65-2).

Russo teaches communicating the movie selection to a program provider (col. 6, ll. 9-12), wherein the program provider of also bills the customers for the recorded selections and movies that actually played (col. 5, ll. 1-10), wherein the program provider is a location remote from the viewer, which reads on receiving information from the first user station at a remote location indicating that a selected digital data content item has been displayed.

Russo teaches selecting using viewer preference information, but Russo is silent on a criteria based on popularity.

Salganicoff teaches using national popularity as a criterion in suggesting programming to a user (col. 48, ll. 27-45). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Russo by selecting based on popularity as taught by Salganicoff in order to provide popular content to the user thereby providing content that is the most desirable to the customer during a time frame (Salganicoff: col. 4, ll. 60-64).

Regarding claims 60, 146, and 152, Russo is teaches on transmitting classification information, comparing the classification information, and automatically selecting the programs to be stored (col. 3, ll. 12-16). However, Russo is silent on the classification information being in the header. Official Notice is taken that indirect classification information being in the header is well known such as using classification identifying PIDs of an MPEG stream, wherein the PIDs by definition of MPEG is located

in the header. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Russo by identifying classification information being in the headers in order to efficiently determine whether the content would be desirable to the user.

9. Claims 61-63, 148-150, and 154-156 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,619,247 to Russo and U.S. Patent 5,734,720 to Salganicoff in view of WO 92/22983 to Browne et al. (Browne).

Regarding claims 61-62, 148-149, and 154-155, Russo is silent on overwriting the oldest stored data. Browne teaches deleting the oldest stored data (pg. 7-8, ll. 20-5). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Russo by deleting the oldest stored data as taught by White in order to remove content least desirable to the user.

Regarding claims 61, 63, 148, 150, 154, and 156, Russo is silent on overwriting the older released data. Browne teaches deleting the oldest stored data (pg. 7-8, ll. 20-5), which equates to "older released data" in that the data is the oldest data transmitted (e.g. released) from the transmitter. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Russo by deleting the older released data as taught by White in order to remove content least desirable to the user.

10. Claims 61, 64, 146, 151, 154, and 157 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,619,247 to Russo and U.S. Patent 5,734,720 to Salganicoff in view of U.S. Patent Application Publication 2002/0056112 to Dureau et al.

Regarding claims 61, 64, 146, 151, 154, and 157, Russo is silent on overwriting the least fit preferences of the customer. Dureau teaches deleting the least fit preferences to make room for more programming (pg. 6, para. 0051). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Russo by deleting the least fit preferences as taught by Dureau in order to remove content least desirable to the user thereby creating space for new programming.

Conclusion


11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Y. Koenig whose telephone number is (571) 272-7296. The examiner can normally be reached on M-Fr (8:30 - 5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571)272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Andrew Y Koenig
Primary Examiner
Art Unit 2623

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